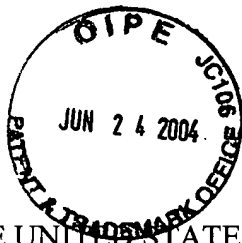


Serial No. 09/083,422
Filed 05/22/98



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Scott Clare
Neil G. Long

Serial No.: 09/083,422

Filed: May 22, 1998

For: A STORAGE SYSTEM FOR VEHICLES

Group Art Unit: 3612

Examiner: Dennis H. Pedder

Atty. Dkt. No.: INN643/4-013

Confirmation No. 3984

CLARE AND LONG APPEAL BRIEF

I. REAL PARTY IN INTEREST

The real parties in interest are Scott Clare, Neil Long and the exclusive licensee of this patent application, Innovative Truck Storage, Inc. (a small entity, which has granted a sublicense under this application to Royal Truck, Inc., another small entity).

II. RELATED APPEALS AND INTERFERENCES

There are no currently-pending related appeals or interferences.

III. STATUS OF CLAIMS

This application was filed on May 22, 1998, with Claims 1-23. Claims 6, 8, 9, 13 and 15-23 were canceled and Claims 24-33 added in a preliminary amendment filed concurrently. Claims 34-42 were added by amendment and claim 29 was cancelled in a response to the Office Action of August 18, 1998. Claims 43-48 were added by amendment in a response to the Office Action of October 18, 1998. A Continued Prosecution Application (CPA) was filed on December 29, 2000 canceling Claims 2-5, 7, 10-12, 14, 24-28 and 30-48, and adding new Claims 49-97. Claims 75-84, 90 and 95 were canceled as drawn to a non-elected species and Claims 98-127 were added in a response to the Office Action of June 6, 2001. Claim 1 was canceled as drawn to a non-elected invention and Claims 63, 102, 112 and 117 were canceled in a response to the Final Office Action of February 1, 2002. Claims 100, 103, 104, 107, 110, 115, and 125 were canceled in a response to the Office Action of July 12, 2002. Finally claims 114, 116 and 118-124 were cancelled on January 9, 2003.

Claims 49-62, 64-74, 85-89, 91-94, 96-99, 101, 105, 106, 108, 109, 111, 113, 126 and 127 are in the case. Claims 94, 96, 97, 126, and 127 are allowed. Claims 57, 74 and 87 are objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 49-56, 58-62, 64-73, 85-86, 88-89, 91-93, 98, 99, 101, 105, 106, 108, 109, 111, and 113 stand rejected.

IV. STATUS OF AMENDMENTS

No amendments of the claims have been submitted after the Final Office Action. Applicants submitted an Information Disclosure Statement after the Final Office Action and have received notice attached to the Notice of Non-Compliance of May 24, 2002 that the submitted documents have been considered by the Examiner.

V. SUMMARY OF INVENTIONS

The instant inventions involve enclosed light trucks such as family vans and sport utility vehicles that include a unique storage system. These vehicles typically have a cargo or seating area behind the front seat that includes a floor area and outer walls. The floor conventionally extends over the rear wheels and a raised area called the wheel wells rises above the level of the floor and inside the outer walls in the cargo area. The instant inventions include vehicles in which a storage area is adjacent to, but separate from the cargo area and extends into the cargo area no further than the wheel wells (Claim 49). In certain embodiments, the storage areas may extend over the wheel well (Claim 50), forward of the wheel well or rearward of the wheel well (Claim 51). The storage areas are accessible from outside the vehicle and a hinged opening in the exterior of the vehicle provides access to the storage system (Claim 58).

Because it is often awkward to store or carry materials within the area over or in front of, or behind the wheel wells, the storage systems do not significantly decrease the useable storage volume within the vehicle cargo area, but rather add a useful storage compartment, analogous to a car trunk. The storage systems do not substantially alter the appearance of the exterior of the vehicles, which maintain the aesthetically appealing contours of a conventional vehicle without the extra storage space. Thus, in these embodiments, the side panels of the rear portion of the vehicle are aligned with the side panels of the driver's compartment as in a conventional vehicle without the storage

system (Claim 85), or the separation width and cross-sectional contour of the side panels of the rear of the vehicle containing the storage system are substantially the same as the separation width and cross-sectional contour of the forward compartment where it adjoins the side panels of the rear area (Claim 61).

VI. ISSUES

1. Are Claims 49-56, 58, 60, 85-86, 89, 92, 93, 98, 99, 101, 105, 106, 108, 109, 111 and 113 properly rejected under 35 U.S.C. § 103(a) over Hamel (U.S. Patent No. Des. 230,351), in view of Powers (U.S. Patent No. Des. 143,990), or Douglass, Jr. (U.S. Patent No. 3,068,038)?

2. Are Claims 59 and 88 properly rejected under 35 U.S.C. § 103(a) over Hamel, in view of Powers, or Douglass, Jr., and Gallager (U.S. Patent No. 5,709,309)?

3. Is Claim 91 properly rejected under 35 U.S.C. § 103(a) over Hamel, in view of Powers, or Douglass, Jr., and Itoh (U.S. Patent No. 4,194,782)?

4. Are Claims 61, 62, and 64-73 properly rejected under 35 U.S.C. § 103(a) over Hamel (U.S. Patent No. Des. 230,351), in view of Powers (U.S. Patent No. Des. 143,990), or Douglass, Jr. (U.S. Patent No. 3,068,038), in view of Shelby, Jr.?

VII. GROUPING OF CLAIMS

A. As regards the rejection over Hamel combined with various secondary references, Claims 49-56, 58-60, 93, 98, 99, 101, 105, 106, 108 stand or fall together, Claims 61-62, 64-73, 109, 111, 113 stand or fall together, and Claims 85-86, 88, 89, 91-92 stand or fall together and each of the three groups are separately patentable.

As regards the obviousness rejections of the pending claims, Claim 49 and claims dependent thereon and Claims 85 and claims dependent thereon are separately patentable from Claim 61 and claims dependent thereon as Claims 49 and 85 are drawn to vehicles comprising a driver's compartment and a rear compartment contained within the same enclosure or within a contiguous enclosure.

As regards the obviousness rejections of the pending claims, Claim 49 and claims dependent thereon and Claim 85 and claims dependent thereon are separately patentable as Claim 49 is drawn to vehicles in which the storage area is defined by at least a portion of an outwardly bowed exterior side panel, an inner panel, a top and bottom which

connect the inner panel to the exterior side panel, and wherein the storage area extends into the cargo area no further than the wheel well extends into the cargo area, and Claim 85 is drawn to vehicles containing the described storage in which the side panels of the rear compartment are substantially aligned with the driver's compartment.

It should be noted that all of these claims were rejected using Hamel (Des. 230,351) as a primary reference and either Powers (Des. 143,990) or Douglass, Jr. (Pat. No. 3,068,038) as secondary references, alone or in combination with tertiary references. Therefore, a finding that Hamel, alone or in combination with either Powers or Douglass, Jr., teaches away from Appellants' inventions or is not properly combined to form the basis of a rejection of Appellants' inventions, will render all claims patentable over the prior art.

VIII. ARGUMENT

A. The Rejection of Claims 49-56, 58, 60, 85-86, 89, 92, 93, 98-99, 101, 106, 108, 109, 111 and 113 Under 35 U.S.C. 103(A) Over Hamel, In View of Powers or Douglass, Jr. Should Be Overturned.

The Final Action uses Hamel as a primary reference to reject the above-recited claims in the case, asserting that the Hamel design patent has "all claimed details less the short extension of the storage area, a feature known in this art as evidenced by either Powers, as shown in Figures 3 and 5, or Douglass, Jr. as can be seen in Figure 3." The Action states that "it would be obvious to a person of skill in the art to provide in Hamel a storage area of slightly lesser depth relative to the wheel well as taught in Powers or substantially equal depth as taught by Douglass, Jr." The final rejection also asserts that Douglass, Jr. provides latches as in Claim 53 and struts as in Claim 56, and further rejects Claim 108 on the basis that process steps lack patentable weight in a product claim. For the reasons explained below, Applicants respectfully traverse each of these rejections.

1. The Cited References Do Not Teach or Suggest Every Limitation of the Claims, and Thus the Rejection Under §103 Is Improper.

These rejections are improper and should be withdrawn because the cited references do not, either alone or in combination, come close to teaching or even suggesting a vehicle with each and every limitation of the appealed claims. Specifically, the references do not teach or suggest at least the following claim limitations: (1) driver

and passenger compartments that are not physically separated; and (2) vehicles that have contoured or outwardly bowed side panels, such as those of conventional non-utility vehicles, while simultaneously providing the claimed storage areas.

a. The Cited Art Does Not Teach or Suggest Vehicles Where the Driver and Passenger Compartments Are Not Physically Separated

Each of the claims rejected in Part II of the Final Rejection¹ contain limitations not taught or suggested by Hamel in combination with either Powers or Douglass, Jr. To begin, the cited references do not teach or suggest a vehicle in which the driver and passenger compartments are not physically separated. Independent claim 49 (from which rejected claims 50-56, 58, 60, 93, 98, 99, 101, 105, 106 and 108 depend) is directed to:

“a vehicle having a driver compartment and a cargo area disposed to the rear of the driver compartment within a contiguous enclosure, wherein the enclosure is defined by a floor, a roof, two opposing side walls which each connect the roof to the floor, and exterior side panels”

Similarly, independent claim 85 (from which rejected claims 86, 89 and 92 depend), relates to “a vehicle comprising a driver’s compartment and a rear compartment contained within the same enclosure...”

Appellants do not find in any of the three cited references, a description or suggestion of a vehicle that includes a driver's compartment and a rear compartment contained in the same, or a contiguous enclosure. Hamel contains a design for a commercial utility van, and clearly indicates a physical barrier between the rear portion of the van and the cab. Specifically, Figure 3 of Hamel is a top sectional view taken just below the roof and shows, by the hatched line that separates the cab enclosure from the rear enclosure, that it lacks this claim limitation because the rear compartment is separated from the cab by a bulkhead or similar structure. Nor is there any written description in Hamel describing the claimed vehicles in which the driver compartment and passenger compartment are not separated by a physical barrier. Additionally, neither Powers nor Douglass, Jr. (the secondary references cited) show or describe this claim element. In the heavy construction truck shown in Powers, the rear compartment is

¹ As noted above in the heading at section VIII(A), this rejection was of claims 49-56, 58, 60, 85-86, 89, 92, 93, 98-99, 101, 106, 108, 109, 111 and 113.

clearly separate from the cab compartment. This can be seen in Figures 1, 2, 4 and 5, which show the bulkhead separating the compartments. Furthermore, Douglass, Jr. describes a pickup truck converted to a utility truck in which the rear compartment is a separate, open utility bed. Thus, the cited references are completely lacking at least one claim limitation, and no combination of the three references in any way teaches or suggests the claimed inventions. Accordingly, the rejections are improper, and should be withdrawn with respect to claims 49-56, 58, 60, 85-86, 89, 92, 93, 98-99, 101, 106, and 108.

b. The Cited Art Does Not Teach or Suggest Vehicles With Contoured or Outwardly Bowed Side Panels.

Each of the rejected claims 109, 111 and 113 depends from claim 61 which is directed to vehicles “wherein the enclosure is bounded by exterior, contoured side panels.” Further, claim 49 (from which rejected claims 50-56, 58, 60, 93, 98, 99, 101, 106 and 108 depend) is directed to vehicles with a storage area “defined by at least an outwardly-bowed exterior side panel.” The claims are thus distinguished from the cited art, all of which refer to vehicles used for utility work or in heavy construction, containing flat or linear doors to enclose the storage they depict. Specifically, Hamel depicts a van with storage accessible from the side, wherein the doors to the storage are flat, hinged panels that do not appear to provide contours or an “outward bow” to the exterior of the storage area when in a closed position. What Hamel shows is therefore clearly distinct from the claimed vehicle storage systems which are “defined by at least a portion of an outwardly-bowed exterior side panel.” The plain meaning of “outwardly-bowed” is evident: a convex curved exterior side panel. It does not mean “flat doors that meet at an obtuse angle” as shown in Hamel. In other claims, the claimed vehicles have an enclosure that is “bounded by exterior, contoured side panels.” Again, the plain and ordinary meaning of “contoured” is clear and well understood; it means the curving nature of an object. Hamel in no way teaches or suggests either an “outwardly-bowed exterior side panel” or a “contoured side panel.” Thus Hamel does not teach or suggest storage such as that in the appealed claims in a vehicle with contoured side panels.

Powers and Douglass, Jr. do not help Hamel in forming the basis for the rejection. As with Hamel, design patent Powers and utility patent Douglass, Jr. both relate to a

utility truck with flat exterior panels enclosing storage compartments. None of Hamel, Powers or Douglass, Jr. even has or refers to a single contoured side panel or storage compartment and Douglass, Jr. actually lacks side panels altogether. Instead, Douglass, Jr. teaches away from Appellant's claims and has a storage box extending well beyond the width of the cab and frame and having upstanding non-contoured side walls "to form with the floor member a rigid box-like structure." (See, e.g., col. 2, lines 31-36 and Fig. 3 of Douglass, Jr.).

Further, there is no disclosure or motivation in Hamel, Powers or Douglass, Jr. to employ contoured side panels or compartments. A skilled artisan reading these references would find no motivation to alter the appearance or conformation of the cited vehicles and the Examiner has not pointed to any such motivation contained in the references nor in the general knowledge in the art. This is especially true in light of Douglass, Jr.'s concern that "an important feature of the invention" is supporting the geometric configuration of a rectangular box using transverse members. (col. 2, lines 17-21). Why would the skilled artisan believe a compartment shaped other than a rectangular box (such as a contoured shape) would provide the advantages described by Douglass, Jr.? What's more, the entire teaching of Douglass, Jr. is away from any form of contoured shape since it would defeat the objective of Douglass, Jr. and was never remotely contemplated. Additionally, although the top portion of the rear compartment in Powers appears to be curved, this top section is not the side panel of the vehicle, which contains no contours or outwardly bowed panels.

Accordingly, Hamel combined with Powers or Douglass, Jr. does not, in fact, teach or suggest the claimed inventions, and therefore the rejection is improper; the rejection of claims 49-50-56, 58, 60, 93, 98, 99, 101, 106, 108, 109, 111 and 113 should be withdrawn.

2. None of Hamel, Powers or Douglass, Jr. Describes or Suggests a Vehicle That Addresses the Problem of How To Provide Storage, Particularly Storage That Is Accessible From the Exterior of the Vehicle, by Utilizing Space That Is Conventionally Inaccessible or Poorly Accessible, While Maintaining the Aesthetic Contours of a Non-Commercial Vehicle.

The pending claims establish some of the inventors' solution(s) to the stated problems by locating a storage space or compartment between the outer side panel and an

inner wall such that the storage compartment is essentially contained within the width of the wheel well so no usable space is lost inside the vehicle, and the contours of the side panels are substantially unchanged to maintain the aesthetic appeal of the vehicle. In certain embodiments the inventions further provide a hinged panel for access to the storage compartment.

These features are claimed as storage systems in which "the storage is defined by at least a portion of an outwardly bowed exterior side panel", and "wherein the storage area extends into the cargo area no further than the wheel well extends into the cargo area," (Claim 49); "wherein the enclosure is bounded by exterior, contoured side panels," "at least one storage area disposed between a rear-most one of said side doors and the rear of the vehicle, and adjacent at least one exterior, contoured side panel and extending into the enclosure of the vehicle no further than the wheel well extends into the enclosure," and "further wherein the separation width and cross sectional contour of the side panels of the enclosure is substantially the same as the separation width and cross-sectional contour of the forward compartment where it adjoins the side panels of the enclosure" (Claim 61); and finally "wherein the side panels of the rear compartment are substantially aligned with the driver's compartment," and "wherein the width of the storage area is not greater than the width of the wheel well" (Claim 85). This claim language is fully supported by the drawings, particularly in Figures 5, 8A, 8B, and 18.

It is clear from a review of the cited art, that the claimed inventions address a problem that is not even contemplated by the cited references: the problem of how to provide storage, particularly storage that is accessible from the exterior of the vehicle, by utilizing space that is conventionally inaccessible or poorly accessible, while maintaining the aesthetic contours of a non-commercial vehicle. Since the cited references do not contemplate the problem, there is no way they can suggest a solution to the problem and cannot render the claims obvious; the cited art is improperly cited and combined to form the basis of the present rejections.

The primary reference, Hamel, does not address these problems. The design shown in Hamel is a commercial utility van that appears to be full of cabinets and drawers. This design makes no attempt to limit the depth of the externally accessible storage to minimize its impact on the interior space of the rear compartment. Indeed,

figures 2 and 3 indicate that the storage compartments extend well into the rear compartment. Neither does the Hamel design make any attempt to create the look of a conventional vehicle that lacks the claimed storage. The Hamel vehicle is a boxy, rectangular utility truck with linear panels that open to provide access to the storage area, and that meet in obtuse angles on the exterior of the truck. This design bears no resemblance to the invention of the appealed claims, and in no way suggests the inventions of these claims.

The Board's attention is drawn to the panels of the Hamel design patent. These are shown in Figures 1, 2 and 4 as flat, planar surfaces with no hint of an outwardly bowed contour, or of any attempt to have any contoured exterior surfaces. Neither do the bottom panels as seen in Figures 1 and 4 appear to be anything but flat and planar. This is also illustrated in Figure 4 at the rear wall, which appears to be two straight lines joined by an obtuse angle. Therefore, not only is the utility truck shown in Hamel completely lacking a description of a vehicle with a single or contiguous enclosure, it also fails to describe the configurations of the side panels of the vehicles as in the appealed claims. As in Powers, the fact that the side of the vehicle and roof may not meet at a right angle, but rather contain a bit of a radius does not change the fact that the side panels are not contoured or outwardly bowed.

The following claim elements are also completely missing from Hamel:

- (i) the storage area being defined by at least a portion of an outwardly bowed exterior side panel, an inner panel, a top and bottom which connect the inner panel to the exterior side panel, and wherein the storage area extends into the cargo area no further than the wheel well extends into the cargo area (Claim 46),
- (ii) wherein the enclosure is bounded by exterior, contoured side panels (Claim 61);
- (iii) wherein the separation width and cross sectional contour of the side panels of the enclosure is substantially the same as the separation width and cross-sectional contour of the forward compartment where it adjoins the side panels of the enclosure (Claim 61); and,

- (iv) wherein the side panels of the rear compartment are substantially aligned with the driver's compartment (Claim 85).

Further, Powers does not contain or suggest the missing claim elements. Powers is a design of a truck clearly intended for use in heavy construction. A person skilled in the art would not consider this reference relevant when attempting to solve the problems solved by the present inventions. Nor does it teach or suggest the external configurations contained in the appealed claims. Although the top portion of the rear compartment in Powers appears to be curved, this top section is not the side panel of the vehicle, which contains no contours or outwardly bowed panels. The sides of the vehicle are large, boxy storage compartments as would be expected in a utility truck or a heavy commercial truck as shown. Nothing about this truck design suggests that it could be modified to be combined with the Hamel design, nor that such a combination would suggest the claimed inventions. In fact, Hamel in combination with Powers would teach away from the claimed inventions by reinforcing the concept of flat panels covering storage in the side of utility-type vehicles. The Hamel and Powers references are thus improperly combined in this rejection and Appellants respectfully request the Board to overturn all rejections over the combination of the Hamel and Powers designs.

Douglass, Jr. also fails to cure the deficiencies of the Hamel and Powers designs. Douglass, Jr. describes a utility truck made from a pickup in which the bed has been replaced with an open utility bed. Thus this patent describes a completely different type of vehicle. In addition, the utility bed contains boxy rectangular utility boxes that in no way meet the claimed inventions and in no way suggest the contoured vehicle side panels of the claimed inventions. Appellants find no suggestions in Douglass, Jr. that the described truck could be combined with a utility van as in the Hamel design or a heavy commercial truck as in the Powers design and certainly no suggestion that such a combination would arrive at the claimed inventions. Douglass, Jr. is thus improperly combined with Hamel and Powers references in making this rejection.

Further, as noted in part 1(b), above, Douglass, Jr., alone and in combination with Hamel, clear teaches away from the claimed inventions. Claim 61 includes the limitations: "*wherein the separation width and cross sectional contour of the side panels of the enclosure is substantially the same as the separation width and cross-sectional*

contour of the forward compartment where it adjoins the side panels of the enclosure" and claim 85 includes the limitations that *"wherein the side panels of the rear compartment are substantially aligned with the driver's compartment,"* and *"wherein the width of the storage area is not greater than the width of the wheel well."* In contrast, Douglass, Jr. discloses a truck having sidewalls well outside the width of the cab and therefore having a cargo area with a substantially greater horizontal width than that of the cabin.

Thus, Douglass, Jr. teaches away from the aforementioned horizontal width and centering requirements. Douglass, Jr. refers to the outboard rectangular boxes extending well beyond the frame 14, the cab 11 and doors. (Fig. 3). The large width of the outboard storage compartments in relation to the cabin and frame is why it is so important for Douglass, Jr. to provide the transverse members 21-24 which extend across to support the boxes which are outside the support of the frame. Specifically, it is stated that "[as] an important feature of the invention, transverse members 21-24 extend entirely across the truck bed and serve not only to support the floor member, but also the various boxes, outboard from the flooring." (col. 2, lines 17-21).

That the box is well outside the width of the passenger cabin is confirmed by Douglass, Jr.'s need to have "the side walls terminate at substantially less than shoulder height" (col. 2, lines 55-60). In this manner, Douglass, Jr. touts "better visibility" (col. 2, line 47) because the outboard boxes do not substantially interfere with the view from the rear window or side mirrors. Having the box outside the width of the passenger cabin in Douglass, Jr. also offers "improved balance and roadability" (col. 1, lines 44-45), and a lower center of gravity. (col. 3, lines 27-30). By practicing the Douglass, Jr. invention, the advantages of the presently claimed inventions are simply not met.

Further, a proposed modification cannot render the prior art unsatisfactory for its intended purpose. (M.P.E.P. § 2143.01). In the instant case, changes that would have to be made to Douglass, Jr. to achieve the claimed invention would render Douglass, Jr. unsatisfactory for its intended purposes of "improved balance and roadability." (col. 1, lines 44-45). That is, by not having the sidewalls of the bed well outside the width of the cab, the Douglass, Jr.'s balance would likely not be improved. What's more, the proposed modification could also defeat Douglass, Jr.'s stated purposes of "increas[ing]

the storage capacity of the truck bed” and “help[ing] to lower the center of gravity of the truck, either loaded or empty.” (col. 3, lines 27-30). Accordingly, Appellants respectfully request the Board to overturn all rejections over the combination of the Hamel or Powers designs and Douglass, Jr.

3. The Final Official Action Completely Fails to Establish a *Prima Facie* Case of Obviousness in the Present Application and Thus the Present Rejections Under § 103(A) Are Improper and Should Be Overturned.

The three basic criteria for a *prima facie* case of obviousness are: (i) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, (ii) there must be a reasonable expectation of success, and (iii) the prior art reference or references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The teachings and suggestions to make the claimed combination and the reasonable expectation of success *must both be found in the prior art*, not in applicant's disclosure. *Id.* As discussed above, the Final Action fails to establish a *prima facie* case of obviousness of any of the claimed inventions.

To begin, there exists no suggestion or motivation in the cited references to modify them to provide the claimed inventions. On their face, the Hamel and Powers references are design patents, thus provide no more than the figures shown, and as detailed above, the Douglass, Jr. reference affirmatively *teaches away* from the claimed inventions. Also as detailed above, none of the references intend to solve the same problem as the inventions in the appealed claims. As a result, the combination of these references is not only improper, it is insufficient to establish the legal requirement that they, alone or in combination, teach or suggest being modified to provide all the elements of the claimed inventions.

Further, the Action completely fails to provide any reasonable expectation that such modifications of the combined references would successfully create the claimed invention. In light of the clear deficiency in meeting the first prong of the test for obviousness by combining references, the Action cannot hope to have established the second criteria for obviousness.

In failing to meet the first two required aspects of a *prima facie* case of obviousness, the Action even admits that the claimed configuration of the storage area is not taught nor suggested in the Hamel design. The Action then fails to provides any motivation from the other art to modify the Hamel design to reach the claimed invention. The Examiner merely points to Powers and Douglass, Jr. as teaching that "shorter storage areas" is a feature known in the art. Assuming for the sake of argument that this feature is something taught by the Powers or Douglass, Jr. references (it is not), this still fails to establish a motivation to combine the cited references.

There is no suggestion in Hamel that increasing, or not diminishing the interior of the van is in any way needed or desired. In fact, attempting to shrink all the storage cabinets disclosed in Hamel into the width of the wheel wells would make them essentially inoperable for their intended use, which appears to be to maximize the storage accessible from the sides of the truck. The Hamel design thus teaches away from the claimed invention. Further, there is no motivation in Powers or Douglass, Jr. to modify those references, or others, to provide the inventions of the appealed claims. The only motivation to modify Hamel appears to be to construct the claimed invention in hindsight. As is well established in patent law, the Examiner is not allowed to use the claims as a blueprint to pick and choose elements from the prior art in order to reconstruct the invention. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985).

Even this improper attempt to reconstruct the claimed invention fails, however, because the combination of references in the Action fails to provide teaching or suggestion of all the claim elements, thus failing to meet the third requirement for establishing a *prima facie* case of obviousness. Federal Circuit precedent dictates that, to properly establish an obviousness rejection, the combination of prior art must teach or suggest *each and every* claim limitation. As explained above, the three cited references fall far short of this requirement. Specifically, the cited references do not teach or suggest at least the following limitations of the appealed claims:

- (i) a passenger and driver compartment in a "contiguous enclosure" (Claim 49 and claims depending therefrom²);

² Claims 50 – 60, 93, 98-99, 101, 105, 106 and 108 depend from claim 49 and thus include all limitations of claim 49.

- (ii) “exterior contoured side panels” (claim 61 and claims depending therefrom³)
- (iii) “outwardly bowed” side panels (Claim 49 and claims depending therefrom); and
- (iv) “side panels of the rear compartment are substantially aligned with the driver’s compartment” (Claim 85 and claims depending therefrom⁴).

Because the Examiner has failed to establish a legal case of obviousness, Appellants respectfully request the Board to overturn all rejections under §103(a).

4. Because the Primary (Hamel) and Secondary (Powers and Douglass, Jr.) References Do Not Establish a *Prima Facie* Case of Obviousness Regarding Any Rejected Independent or Dependent Claims, The Rejection of Claims 53, 56 and 108 Are Improper.

As explained above, the Hamel reference in view of either Powers or Douglass, Jr. does not establish a *prima facie* case of obviousness for any of the claims, and this includes for claims 53, 56 and 108. The Final Action further states that, in regard to Claim 53 latches can be seen in Figure 1 of '351, and that struts are also seen, in reference to Claim 56. Regarding Claim 108, the Final Action states that process steps are not given patentable weight in a product claim. Because the cited references do not teach or suggest the other limitations to the claims (again, as explained above) they cannot, as a matter of law, render claims 53, 56 and 108 obvious. Accordingly, the rejections to claims 53, 56 and 108 should be withdrawn.

B. Because the Primary (Hamel) and Secondary (Powers and Douglass, Jr.) References Do Not Establish a *Prima Facie* Case of Obviousness, the Addition of Any Tertiary References is Likewise not Sufficient to Establish a *Prima Facie* Case of Obviousness.

1. The Rejection of Claims 59 and 88 Under 35 U.S.C. 103(a) Over Hamel in View of Powers or Douglass, Jr. and Gallagher (U.S. Patent No. 5,709,309) Should Be Overturned.

Claims 59 and 88 are claims that depend from Claims 49 and 85, respectively. The Final Action states that it would be obvious to one of ordinary skill in the art to provide in the Hamel design, “as modified above a drain relief valve as taught by

³ Claims 62, 64-74, 109, 111 and 113 depend from claim 61 and thus include all limitations of claim 61.

⁴ Claims 86-89, 91 and 92 depend from claim 85 and thus include all the limitations of claim 85.

Gallagher et al. at 18 in order to drain excess moisture.” Presumably when the Action states “as modified above” it means, “as constructed in accordance with the rejected claims” submitted by Applicant. As explained in detail above, Applicants’ claims 49 and 85 (from which the claims 59 and 88 depend) are improperly rejected. The only “modification” that results in the claimed inventions is a novel and non-obvious one accomplished by applicants. Accordingly, modifying the novel and non-obvious independent claims 49 and 85 to provide claims 59 and 88 with at least one drain/air relief valve assembly mounted in at least one storage area does not render claims 59 and 88 unpatentable. Because the independent claims are improperly rejected, the claims that depend from them are also improperly rejected. Gallagher does nothing to rectify the deficiencies in the primary (Hamel) and/or secondary (Powers and Douglass, Jr.) references. Accordingly, the rejection of claims 59 and 88 over Hamel in view of Powers or Douglass, Jr. and Gallagher should be withdrawn and these claims should be allowed along with the independent claims from which they depend.

2. Claim 91 is Not Obvious Over Hamel in View of Powers or Douglass, Jr. and Itoh (U.S. Patent No. 4,194,782); The Rejection of Claim 91 Should Be Overturned.

As with the rejection of claims 59 and 88, the Action states that claim 91 is rejected because, according to the Action, “it would have been obvious to one of ordinary skill in the art to provide in Hamel as modified above seating in the cargo area as taught by Itoh.” Again, presumably when the Action states “as modified above” it means, “as constructed in accordance with the rejected claims” submitted by Applicant. As explained in detail above, Applicants’ claim 85 (from which claim 91 depends) is improperly rejected. The only “modification” that results in the claimed inventions is a novel and non-obvious one accomplished by applicants. Combining Powers or Douglass, Jr. with Hamel is improper, and does not establish a *prima facie* case of obviousness. Further combining Itoh with these references does not, therefore, render claim 91 obvious. Accordingly, the rejection of claim 91 should be overturned.

3. Claims 61-62 and 64-73 Are Not Obvious Over Hamel in View of Either Powers or Douglass, Jr. Optionally in View of Shelby, Jr.; the Rejection of These Claims Should Be Overturned.

As with the rejection of claims 59, 88 and 91, the Action states that claims 61-62 and 65-73 are rejected because, according to the Action, "it would have been obvious to one of ordinary skill in the art to:

provide in Hamel a storage area of slightly lesser depth relative the wheel well as taught by Powers or substantially equal depth as taught by Douglass, Jr. in order to maximize the main cargo area between the storage area...Optionally it would have been obvious to one of ordinary skill in the art to provide in Hamel as modified by either Powers or Douglass, Jr. a cargo area side door 12, 14 as taught by Shelby Jr. in order to load from the side. Shelby Jr. shows the wheel well curve on the side panel.

Again, as explained above regarding the rejections over Hamel in view of Powers or Douglass, Jr., the combination of these references does not establish a *prima facie* case of obviousness for the independent claim or for the dependent claims. Accordingly, the rejection based on Hamel in view of Powers or Douglass is clearly improper and should be withdrawn. The further combination of Shelby with these references does nothing to save the shortcomings of the base rejection.

Again, presumably when the Action states "as modified above" it means, "as constructed in accordance with the rejected claims" submitted by Applicant. As explained in detail above, Applicants' claim 61 (from which claim 62 and 65-73 depend) is improperly rejected. The only "modification" that results in the claimed inventions is a novel and non-obvious one accomplished by applicants. Combining Powers or Douglass, Jr. with Hamel is improper, and does not establish a *prima facie* case of obviousness. Further combining Shelby with these references does not, therefore, render the claims obvious. Accordingly, the rejection of claims 61-62 and 65-73 should be overturned.

4. The Examiner Has Not Properly Relied on the Knowledge Generally Available to One of Ordinary Skill in the Art to Cure the Lack of Motivation to Combine the Cited References; No Motivation is Found in the References, and no Motivation is Found in the Knowledge Generally Available to One of Ordinary Skill.

The Final Action states at page 5:

Further, the alternative statement of i) that knowledge generally available to one of ordinary skill in the art is also applicable here as one of ordinary skill or even one of less than ordinary skill knows that a size of a storage area can be altered as desired depending on the amount and size of the contents to be place therein.

This statement by the Examiner demonstrates a complete lack of understanding of the claimed inventions. As stated in the claims, the size of the inventive storage areas of the claimed inventions is not determined by the "amount and size of the contents to be placed therein" as erroneously stated by the Examiner, but the size is rather determined by the ability to utilize the previously inconvenient or wasted space in the vicinity of the wheel wells without reducing the usable space within the vehicle, while providing a trunk-like storage area accessible from outside the vehicle that does not alter the external aesthetics of a primarily non-commercial vehicle. The Examiner has presented no evidence that this idea even existed prior to the present application. Rather, the Examiner has pointed to alleged knowledge that is irrelevant to the rejected claims. Thus the Examiner has again failed to establish a *prima facie* case of obviousness, and all rejections should be overturned.

C. Claims 57, 74 And 87 Should Be Allowed With No Further Amendments Or Limitations.

The Action objected to claims 57, 74 and 87 as "being dependent upon a rejected base claim, but "allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims." Because the rejections of the base claims are properly overturned in the face of the arguments set forth above, Applicants respectfully submit that these claims too are in condition for allowance as they currently stand, and request that the objection to these claims be withdrawn and the claims allowed.

D. Claims 94, 96-97, 126 and 127 Are Unchanged, Thus Remain Allowed

The Action indicated that claims 94, 96-97, 126 and 127 are allowed. As these claims have not been amended in this Appeal, they remain allowed.

Conclusion

Claims 49-56, 58-62, 64-73, 85-86, 88-89, 91-93, 98, 99, 101, 105, 106, 108, 109, 111, and 113 are patentable over the prior art and the Appellant requests that all rejections be overturned.

In the meantime, if the Examiner has any questions or comments, or believes that certain amendments of the claims would advance this case toward allowance, a telephone call to the undersigned Appellant's representative at (512) 542-8446 is earnestly solicited.

Respectfully submitted,

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APPENDIX – CLAIMS ON APPEAL

49. (Three times amended) A storage system for a vehicle having a driver compartment and a cargo area disposed to the rear of the driver compartment within a contiguous enclosure, wherein the enclosure is defined by a floor, a roof, two opposing side walls which each connect the roof to the floor, and exterior side panels, wherein the cargo area includes opposing rear wheel wells extending into the cargo area from the bottom edges of the side panels,
the storage system comprising
at least one storage area adjacent to and separated from the cargo area, the storage area being defined by at least a portion of an outwardly bowed exterior side panel, an inner panel, a top and bottom which connect the inner panel to the exterior side panel, and wherein the storage area extends into the cargo area no further than the wheel well extends into the cargo area,
wherein at least one section of at least one of the outwardly bowed exterior side panels is hinged to provide access to the storage area therein.
50. (Amended) The storage system of Claim 49, wherein at least one storage area extends over at least one rear wheel well.
51. (Amended) The storage system of Claim 49, wherein at least one storage area extends forward and rearward from at least one wheel well.
52. (Amended) The storage system of Claim 49, wherein at least one storage area is constructed to extend along a substantial portion of the side panel.
53. The storage system of Claim 49, wherein the storage area is enclosed and the enclosed storage area includes a plurality of cooperating latch members mounted on the storage area and the at least one hinged section of the at least one side panel.
54. The storage system of Claim 49, further comprising at least one mechanism for retaining the at least one hinged section closed.
55. The storage system of Claim 49, wherein each side of the vehicle is provided with at least one storage area and at least one hinged section.
56. The storage system of Claim 49, additionally including at least one strut assembly operatively connected to retain the at least one hinged section of the side panel in an opened position.

57. The storage system of Claim 56, wherein the at least one strut assembly provides a temperature control during use, the control being insulation, heating, or insulation and heating.

58. (Amended) The storage system of Claim 49, wherein at least one of the side panels includes more than one hinged section that is capable of being opened to expose the storage area.

59. The storage system of Claim 49, additionally including at least one drain/air relief valve assembly mounted in the at least one storage area.

60. The storage system of Claim 49, wherein the at least one storage area includes at least one of an adjustable shelf, a slideable shelf, a movable shelf, or a drawer.

61. (Five times amended) A vehicle having a forward compartment for carrying a driver, and including at least one forward side door providing access to the forward compartment, and an enclosure for passengers, merchandise or equipment wherein the enclosure is disposed to the rear of the driver compartment, and further wherein the enclosure is bounded by exterior, contoured side panels and a rear, including at least one rear door, and optionally at least one rear side door, and wherein each side panel has a lower perimeter that includes a curve to accommodate a wheel well adjacent each side panel;

the vehicle comprising at least one storage area disposed between a rear-most one of said side doors and the rear of the vehicle, and adjacent at least one exterior, contoured side panel and extending into the enclosure of the vehicle no further than the wheel well extends into the enclosure, and wherein the side panel adjacent the storage area includes a hinged section effective to provide an opening from the exterior of the vehicle into the storage area, and further wherein the separation width and cross sectional contour of the side panels of the enclosure is substantially the same as the separation width and cross-sectional contour of the forward compartment where it adjoins the side panels of the enclosure.

62. (Amended) The vehicle of Claim 61, wherein the storage system is located intermediate the driver compartment and the rear door.

64. (Twice Amended) The vehicle of Claim 61, wherein the storage system is mounted in the side panel of the enclosure on the driver's side of the vehicle.

65. (Twice amended) The vehicle of Claim 61, wherein there is a storage system mounted in the side panels of the enclosure on both sides of the vehicle.

66. (Amended) The vehicle of Claim 61, additionally including at least two hinged sections on at least one side of the enclosure, the hinged sections enabling access to at least a portion of the interior of the storage area.

67. (Amended) The vehicle of Claim 61, wherein a storage area is located one of forward or rearward of the wheel well.

68. (Amended) The vehicle of Claim 61, wherein a storage area is located over the wheel well.

69. (Amended) The vehicle of Claim 68, wherein the hinged section is located entirely above the wheel well.

70. (Amended) The vehicle of Claim 68, wherein the hinged section is located over the wheel well.

71. (Amended) The vehicle of Claim 68, wherein the hinged section is located forward and rearward of the wheel well.

72. (Amended) The vehicle of Claim 66, wherein at least one of the hinged sections is hinged horizontally.

73. The vehicle of Claim 61, additionally including at least one strut assembly operatively connected to retain the hinged section in an opened position.

74. The vehicle of Claim 73, wherein the at least one strut assembly provides a temperature control during use, the control being insulation, heating, or heating and insulation.

85. (Four times amended) A vehicle comprising a driver's compartment and a rear compartment contained within the same enclosure, the rear compartment including a storage system, the rear compartment comprising:

a floor area bounded on either side by side panels with exterior surfaces defining the width of the rear compartment, two opposed wheel wells, one at each side of the floor panel, and wherein the side panels of the rear compartment are substantially aligned with the driver's compartment,

at least one hinged section in the exterior surface of at least one of the side panels,

at least one storage area located adjacent the at least one hinged section, and

extending into a cargo area of the vehicle to an inner wall of the storage area, wherein the hinged section is configured to provide access to the storage area when the hinged section is in the open position and wherein the width of the storage area is not greater than the width of the wheel well;

a latch for retaining the at least one hinged contoured side panel section in the closed position; and

a strut for retaining the hinged section in the open position.

86. (Three times Amended) The vehicle of Claim 85, wherein the at least one hinged section is hinged one of horizontally or vertically.

87. (Amended) The vehicle of Claim 85, wherein a temperature control for the strut is provided by at least one of insulating, heating, or heating and insulating.

88. The vehicle of Claim 85, additionally including at least one drain/air relief valve assembly mounted in the at least one storage area.

89. (Twice Amended) The vehicle of Claim 85, wherein the vehicle includes at least one hinged section in each of the side panels and at least one storage area located adjacent the hinged sections.

91. The vehicle of Claim 85, wherein the rear compartment comprises a passenger compartment.

92. The vehicle of Claim 85, wherein the rear compartment comprises a cargo area.

93. (Twice amended) The storage system of Claim 49, wherein the exterior surfaces of the side panels enclosing the cargo area are substantially aligned with the exterior surfaces of the driver's compartment.

94. (Amended) A vehicle comprising a driver's compartment and a rear compartment, the rear compartment including a storage system, the rear compartment comprising:

a floor area with opposing edges, a roof with opposing edges, and bounded on either side by side panels extending from the opposing edges of the floor panel to the opposing edges of the roof, and being outwardly bowed, defining the width of the rear compartment and at least one hinged section in the exterior surface of at least one of the side panels,

at least one storage area located intermediate the side panels, adjacent the at least

one hinged section, and extending into a cargo area of the vehicle, wherein the hinged section is configured to provide access to the storage area when the hinged section is in the open position;-and

a strut for retaining the hinged section in the open position, wherein a temperature control for the strut is provided by at least one of insulating, heating, or heating and insulating.

96. The vehicle of Claim 94, wherein the rear compartment comprises a passenger compartment.

97. The vehicle of Claim 94, wherein the rear compartment comprises a cargo area.

98. The storage system of Claim 49 wherein one section of at least one of the outwardly bowed side panels is hinged to open outwardly to the exterior of the vehicle.

99. The storage system of Claim 49 wherein more than one section of at least one of the outwardly bowed side panels is hinged to open outwardly to the exterior of the vehicle.

101. The storage system of Claim 49 wherein the vehicle having a cargo area is a van.

105. The storage system of Claim 50 wherein the width of the storage area is approximately the same as the width of the wheel well.

106. The storage system of Claim 49 wherein a portion of the sidewall of the cargo area is the opposing side of the inner panel of the storage area.

108. The storage system of Claim 49 wherein the storage system is fabricated on an assembly line.

109. The vehicle of Claim 61 wherein the storage area is inaccessible from the enclosure.

111. The vehicle of Claim 61 wherein the vehicle is a van.

113. The vehicle of Claim 61 wherein the vehicle is fabricated on an assembly line.

126. A storage system for a vehicle having a cargo area and a pair of side panels disposed on either side of the cargo area, the storage system comprising at least one storage area located intermediate the side panels and extending into the cargo area of the vehicle, and comprising:

at least one opening effective to expose the interior of the storage area;

at least one section of at least one of the side panels being hinged, the hinged

section effective to provide access to the storage area therein,
and wherein said storage system comprises at least one strut assembly operatively connected to retain the at least one hinged section of the side panel in an opened position and wherein the at least one strut assembly provides a temperature control during use, the control being insulation, heating, or heating and insulation.

127. A vehicle having a forward compartment for carrying a driver and an enclosure for passengers, merchandise or equipment wherein the enclosure is disposed to the rear of the driver compartment, and further wherein the enclosure is bounded by side panels and a rear wall, including at least one rear door, the vehicle comprising at least one storage area adjacent at least one side panel and extending into the enclosure of the vehicle, and wherein at least one side panel includes a hinged section effective to provide an opening from the exterior of the vehicle into the storage area and a mechanism for securing the at least one hinged section in the closed position,
wherein said vehicle includes at least one strut assembly operatively connected to retain the hinged section in an opened position and wherein the at least one strut assembly provides a temperature control during use, the control being insulation, heating, or heating and insulation.